

UNITED STATES PATENT AND TRADEMARK OFFICE

**MAILED**

**SEP 29 2003**

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte DAVID M. HORNE

Application 09/002,747

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on September 16, 2002. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

On November 8, 2002 this application was returned to the examiner for two reasons. The first reason was that an Information Disclosure Statement filed November 30, 1999 (Paper No. 5) was not considered. The second reason was that claim 11 is missing from the appendix of claims.

Application 09/002, 747

On September 16, 2003, this application was returned to the Board. Attached to the order was a note saying that the IDS was faxed to applicant and that a "copy of claim 11 is here submitted".

However, there are several problems that remain:

- 1) There is no indication on the record that a faxed copy of the IDS was sent to applicant;
- 2) The examiner failed to consider the "Written Opinion, PCT/US98/27591, 10/5/98" on the IDS; and
- 3) There is no appendix of claims attached to either the appeal brief or the Examiner's Answer that contains claim 11.

Appropriate correction of these three elements is required prior to assignment of an appeal number for this application.

Accordingly, it is

**ORDERED** that the following items be corrected prior to this application being returned to the Board of Patent Appeals and Interferences.

- 1) That the examiner consider whether or not the Prior Art "Written Opinion, PCT/US98/27591, or the IDS filed November 3, 1999 is prior art.
- 2) Notify the applicant of said considerations in writing.
- 3) Entering a copy of said consideration into the application file.

Application 09/002, 747

4) Providing an appendix of claims which include an accurate copy of claim 11. This can be done in one of two ways. The first way is to require applicant to file a supplemental appeal brief with an accurate appendix, or by the examiner issuing a supplemental Examiner's Answer containing an accurate appendix of claims, and

5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By:



DALE M. SHAW  
Program and Resource Administrator  
(703) 308-9797

cc: DAVID R. HALVORSON  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN  
12400 WILSHIRE BOULEVARD, 7TH FLOOR  
LOS ANGELES, CA 90025

GJH  
RA03-0559